No. 18-302

IN THE

Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

—v.—

ERIK BRUNETTI,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF *AMICI CURIAE* OF THE AMERICAN CIVIL LIBERTIES UNION AND THE ACLU OF THE DISTRICT OF COLUMBIA, IN SUPPORT OF RESPONDENT

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INTERESTS OF AMICI CURIAE

The American Civil Liberties Union ("ACLU") is a nationwide, nonprofit, nonpartisan organization with nearly 2 million members and supporters dedicated to the principles of liberty and equality embodied in our nation's Constitution and civil rights laws. Since its founding in 1920, the ACLU has frequently appeared before this Court in First Amendment cases, both as counsel of record and as amicus curiae. To preserve the principle of viewpoint neutrality, the ACLU and its affiliates have appeared in many cases throughout the country. Accordingly, the proper resolution of this case is a matter of substantial interest to the ACLU and its members. The American Civil Liberties Union of the District of Columbia is an affiliate of the national ACLU.[1]

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[1] Letters of consent to the filing of this brief have been lodged with the Clerk of the Court. Pursuant to Supreme Court Rule 37.6, counsel for *amici* state that no counsel for any party authored this brief in whole or in part, and no person or entity other than *amici* made a monetary contribution intended to fund preparation or submission of this brief.

SUMMARY OF ARGUMENT

Less than two years ago, this Court unanimously held that the Lanham Act's registration scheme constitutes government regulation of private speech, and that the government therefore cannot approve or deny trademark registration requests on the basis of viewpoint. In *Matal v. Tam*, 137 S. Ct. 1744 (2017), the Court struck down the Lanham Act's "disparagement clause," which prohibited registration of trademarks that may disparage persons, institutions, beliefs, or national symbols, finding that it impermissibly regulates private speech because the speech "expresses ideas that offend." *Id.* at 1751 (unanimous opinion).

The prohibition against registering trademarks that are deemed "immoral ... or scandalous," 15 U.S.C. § 1052(a) (hereinafter "Section 2(a)" or "scandalous-marks provision"), is no less viewpoint-based. It, too, impermissibly regulates private speech because the speech "expresses ideas that offend." Moreover, the principle that the government may not regulate private expression because it deems it immoral or offensive is a bedrock foundation of the freedom of expression. *Texas v. Johnson*, 491 U.S. 397, 414 (1989). If, as this Court held in *Cohen v. California*, 403 U.S. 15 (1971), the First Amendment bars government officials from penalizing someone for wearing a jacket because officials considered its "Fuck the Draft" message offensive, so, too, the First Amendment prohibits officials from denying registration to Respondent's "FUCT" trademark because they deem it "immoral."

In an attempt to save a statute that, read literally, cannot possibly survive constitutional

scrutiny, the government argues that Section 2(a) can be construed to prohibit "vulgar" marks, and that such a prohibition is viewpoint-neutral. Pet. Br. 27. But the government's own enforcement of Section 2(a) has not been limited to an assessment of whether a mark is "vulgar"; it has considered the morality of the viewpoints expressed. In this very case, the Trademark Trial and Appeal Board denied registration under the challenged provision in part because it determined that Respondent's trademarked goods expressed "misogyny" and "extreme nihilism." In any event, substituting "vulgar" for "scandalous" would not cure Section 2(a)'s infirmity, because denying registration on that basis would still constitute viewpoint discrimination; it would simply enforce the viewpoints of the public that ostensibly deems a mark "vulgar."

Even if Section 2(a) is merely content-based, which the government does not contest, it must satisfy strict scrutiny. Yet the government does not even attempt to make the demanding showing required by both content- and viewpoint-based regulations of private speech. The government asserts three interests, but identifies none of them as "compelling," and makes no claim that the scandalous-marks provision is necessary to further the asserted interests, the showing required by strict scrutiny. Indeed, the nexus between the scandalous-marks provision and any legitimate interest is so tenuous that the provision would not even satisfy intermediate scrutiny.

Section 2(a) is also impermissibly vague. The scandalous-marks provision requires government officials to speculate about what a "substantial composite of the general public" would think about a

particular mark. It provides little, if any, guidance to trademark applicants, and therefore risks causing individuals and businesses to self-censor in choosing their marks. The provision imposes on government regulators the impossible task of speculating about what some hypothetical "composite" of the American public will deem immoral or offensive. And because this is unknowable, the standard affords those regulators unbridled discretion to deny registry to marks on the basis of rank speculation. Here, for example, the Trademark Trial and Appeal Board upheld the denial of registration for Respondent's mark, "FUCT," because, *inter alia*: it is a "phonetic equivalent" of a vulgar word; it would be used on clothing that has a theme of "misogyny" and "extreme nihilism"; and the mark's associated imagery is "lacking in taste." Pet. App. 64a. These are quintessentially subjective, ill-defined, and viewpoint-based determinations. Moreover, the record of Section 2(a)'s enforcement is rife with starkly inconsistent applications, in which the same words have been approved for some marks and rejected for others.

Finally, it is indisputable that the government could not deny copyrights and patents to otherwise eligible works on the basis of a bureaucrat's determination that the work was "scandalous." The same ought to hold true for trademarks. Ruling that the "immoral and scandalous" provision is unconstitutional for the same reasons that the "disparagement" provision is invalid would bring trademark law in line with copyright and patent law, both of which secure intellectual property rights without authorizing or requiring the government to

discriminate on the basis of inescapably subjective content- and viewpoint-based judgments.

ARGUMENT

I. THE LANHAM ACT'S PROHIBITION ON REGISTERING TRADEMARKS THAT INCLUDE "IMMORAL ... OR SCANDALOUS MATTER" IS VIEWPOINT-BASED DISCRIMINATION IN VIOLATION OF THE FIRST AMENDMENT.

In *Matal v. Tam*, this Court unanimously held that "[t]rademarks are private ... speech" and that the government cannot prohibit registration of a trademark on the basis that it may "disparage" any "persons, living or dead." *Tam*, 137 S. Ct. at 1744, 1760 (unanimous opinion). The Court reaffirmed the "bedrock First Amendment principle" that "[s]peech may not be banned on the ground that it expresses ideas that offend." *Id.* at 1751 (unanimous opinion). As Justice Alito wrote, "[g]iving offense is a viewpoint." *Id.* at 1763 (plurality opinion). And, in the words of Justice Kennedy's concurring opinion, "the Government's disapproval of a subset of messages it finds offensive .... is the essence of viewpoint discrimination." *Id.* at 1766 (Kennedy, J., concurring in part).

That logic applies with full force to the scandalous-marks provision, which, like the disparagement clause, allows government officials to refuse to register trademarks they deem offensive. The U.S. Patent and Trademark Office ("PTO") has long understood "immoral ... or scandalous matter" to mean "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable ....

[g]iving offense to the conscience or moral feelings ... [or] calling out [for] condemnation." *In re Riverbank Canning Co.*, 95 F.2d 327, 328–329 (C.C.P.A. 1938); *see also In Re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981) (explaining that "the issue we have to decide . . . is whether the mark "BULLSHIT" comprises matter which gives offense to the conscience or moral feelings or is shocking to the sense of decency or propriety of a substantial composite of the general public of the United States"); *In Re Red Bull Gmbh*, 78 U.S.P.Q.2d 1375 (T.T.A.B. 2006) (denying registration because the "term 'bullshit' is offensive to the conscience of a substantial composite of the general public"). According to current PTO definitions, "disparaging" marks are those that might offend a particular person or subset of society, while "scandalous" marks are those that might offend "a substantial composite of the general public." *Id.; see also Trademark Manual of Examining Procedure* (TMEP) (Oct. 2018) §§ 1203.01, 1203.03. In short, the provision targets, not a trademark's *subject matter*, but its "immoral," "offensive," or "disgraceful" *viewpoint*.

In enforcing the scandalous-marks provision, the government "is attempting to remove certain ideas or perspectives from a broader debate"—just as its enforcement of the disparagement clause did. *Tam*, 137 S. Ct. at 1767 (Kennedy, J., concurring in part). This is quintessential viewpoint discrimination. If the government cannot deny registration in order to avoid offense to a particular individual or group, it cannot do so to avoid offending the general public—or, more accurately, what some government official deems to be a "substantial composite of the general public." As this Court

announced long ago, "[t]he fact that society may find speech offensive is not a sufficient reason for suppressing it." *FCC v. Pacifica Foundation*, 438 U.S. 726, 745 (1978).

II. THE GOVERNMENT'S ATTEMPT TO NARROW THE SCANDALOUS-MARKS PROVISION TO PROHIBIT ONLY VULGAR MARKS CANNOT SAVE IT.

The government does not even try to defend Section 2(a) as it has been applied by the PTO, to single out for disfavor those trademarks that government officials deem "immoral" or "offensive" to a "substantial composite of the general public." Instead, the government argues that it is constitutional to deny registration to marks that are "vulgar," a term it insists is viewpoint-neutral because it regulates only the "mode of express[ion]." Pet. Br. 27. That reading is inconsistent with the PTO's long record of interpretation and application. And more importantly, the Court's decision in *Cohen v. California*, 403 U.S. 15, makes clear that such a construction would not save the statute. Outside of narrowly circumscribed situations, the state has no business regulating the "morality" or "offensiveness" of private speech.

As an initial matter, while the government's brief in this Court characterizes the mark in this case as vulgar, it has made no representation that application of Section 2(a)'s scandalous-marks provision is limited to vulgar material. Here, the record makes clear that the government refused to register "FUCT" not simply as "vulgar," but also because it was used in ways that the Board thought reflected "misogyny" and "extreme nihilism." Pet.

App. 64a. However objectionable they may be, misogyny and nihilism are both viewpoints, and the government may not regulate private speech because it believes "a substantial composite of the general public" finds it distasteful or offensive.

Moreover, even if the Court were to accept the government's narrowing construction, a prohibition on the registration of vulgar marks would still run afoul of the First Amendment. The government argues that such a prohibition is viewpoint neutral because it suppresses not a viewpoint, but an "especially offensive mode of expression." Pet. Br. 27–28 (quoting *R. A. V. v. City of St. Paul*, 505 U.S. 377, 393 (1992)). But this formulation is itself ultimately viewpoint-based, as it targets not all speech on a general subject matter, but particular marks that it believes the public will view as offensive. It necessarily enforces the majority's *viewpoint* in determining what can and cannot be registered. *See Tam*, 137 S. Ct. at 1763 (plurality opinion) ("Giving offense is a viewpoint."); *id.* at 1766 (Kennedy, J., concurring) (disapproval of "disparaging" marks is the "essence of viewpoint discrimination").

This Court has refused to "indulge the facile assumption that one can forbid particular words," including the word "fuck," "without also running a substantial risk of suppressing ideas in the process." *Cohen*, 403 U.S. at 26 (holding that government could not punish an individual for wearing a "Fuck the Draft" jacket in a courthouse). Otherwise, "governments might soon seize upon the censorship of particular words as a convenient guise for banning the expression of unpopular views." *Id.* In addition, such a prohibition would unduly inhibit the important "emotive function" of speech, *id.*, and

would offer no limiting principle for stopping short of "cleans[ing] public debate to the point where it is grammatically palatable to the most squeamish among us." *Id.* at 25. Turning to the word "fuck" itself, the Court in *Cohen* held that "while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric." *Id.* This reasoning forecloses the government's arguments that limiting the scandalous-marks provision to prohibit only the registration of vulgar marks would cure its constitutional infirmity.

This Court's narrow acceptance of prohibitions on vulgarity in the specific settings of radio broadcasts, *see Pacifica*, 438 U.S. at 748, and school assemblies, *see Bethel Sch. Dist. No. 403 v. Fraser*, 478 U.S. 675 (1986), does not alter this conclusion. In each case, the Court took pains to limit its holding to a specific context involving children, intrusions into the privacy of the home, or both. In *FCC v. Pacifica*, the Court expressly restricted its decision to the radio broadcast context, which "has received the most limited First Amendment protection," both because it intrudes upon "the privacy of the home, where the individual's right to be left alone plainly outweighs the First Amendment rights of an intruder" and because it "is uniquely accessible to children." 438 U.S. at 748–49. As the court below held, "[t]he government's interest in protecting the public from profane and scandalous marks is not akin to the government's interest in protecting children and other unsuspecting listeners from a barrage of swear words over the radio in *Pacifica*." Pet. App. 37a.

Similarly, in *Bethel*, the Court limited its holding to the school setting, noting that the "rights of students in public school are not automatically coextensive with the rights of adults in other settings." 478 U.S. at 682. Neither case can be read as justifying the regulation of offensive speech outside those contexts. Indeed, the Court in *Bethel* expressly distinguished *Cohen* by noting the limited rights of students. *Id.* at 692 n.2. And in *Cohen* itself, the Court refused to countenance similar restrictions on an adult's speech on government property, even though the government invoked the "presumed presence of unwitting listeners or viewers." 403 U.S. at 21. The Court cautioning that to do otherwise "would effectively empower a majority to silence dissidents simply as a matter of personal predilections." *Id.*[2]

Thus, even if the scandalous-marks provision could be rewritten to prohibit only vulgar trademarks, it would be unconstitutional.

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[2] Nor are the Court's cases addressing obscenity and sexually explicit entertainment zoning relevant. Obscenity is a form of unprotected speech. And the zoning of sexually explicit entertainment has turned on considerations of "secondary effects" rather than the perceived offensiveness of the expression. *See, e.g., Miller v. California*, 413 U.S. 15, 24 (1973) (obscenity); *City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41 (1986) (zoning of adult movie theaters).

III. EVEN IF THE SCANDALOUS-MARKS PROVISION WERE DEEMED VIEWPOINT-NEUTRAL, IT COULD NOT PASS CONSTITUTIONAL MUSTER.

The scandalous-marks provision fails First Amendment scrutiny whether it is deemed viewpoint-based or merely content-based. While the government labors mightily to characterize the provision as viewpoint-neutral, it does not dispute that the provision is content-based. Pet. Br. 19. But strict scrutiny applies to both content- and viewpoint-based regulations of speech. "Content-based regulations are presumptively invalid." *R. A. V.* 505 U.S. at 382; *see also Police Dep't of Chicago v. Mosley*, 408 U.S. 92, 95 (1972). "For the state to enforce a content-based exclusion it must show that its regulation is necessary to serve a compelling state interest and that it is narrowly drawn to achieve that end." *Perry Educ. Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37, 45 (1983). Yet remarkably, the government does not even argue that the scandalous-marks provision can survive strict scrutiny. *See* Pet. Br. 19–30.

Instead, it applies only lenient scrutiny and asserts three interests that it maintains are "substantial" (and notably, not "compelling") and are advanced by the provision (and again notably, not "necessary" to further the asserted interests). Pet. Br. 16. The government invokes interests in: (1) "protecting the sensibilities of the public," *id.* at 32, (2) preserving "the orderly flow of commerce," *id.* at 33–34, and (3) "avoiding any appearance that the government approves of such marks," *id.* at 34. None of these justifications satisfies strict scrutiny. The first and third interests are affirmatively

impermissible bases for regulating the speech of adults, and denying registration to scandalous marks is by no means "necessary" to further the second interest in an orderly flow of commerce.

The government first maintains that "Congress has a legitimate interest in encouraging the use of trademarks that are appropriate for all audiences, including children." Pet. Br. 33. But as noted above, the Court in *Cohen* already rejected limiting adult speech in public on the ground that children may be present. *Cohen*, 403 U.S. at 21. The government "may not reduce the adult population to only what is fit for children." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 875 (1997) (internal quotation marks and alterations omitted). As this Court warned in *Tam*, the government's interest in denying registration to marks that may be offensive to some audiences "strikes at the heart of the First Amendment." *Tam*, 137 S. Ct. at 1764 (plurality opinion). Indeed, "[i]f there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. at 414. The government's purported interest in "protecting the sensibilities of the public" is just another way of saying speech should be prohibited because society finds the idea expressed disagreeable.

The second interest, preserving an "orderly flow of commerce," may be legitimate, but the government has not made any showing that denying registration to "immoral" trademarks is the least restrictive means, let alone necessary, to further that interest. Indeed, the government makes no showing

that marks like Respondent's have any impact whatsoever on the orderly flow of commerce. Such marks can be used without registration, yet the government has offered not even a single anecdote to show how they have disrupted commerce. And as shown in the following section, the PTO has registered many marks that are indistinguishable from marks that other PTO officials have deemed "scandalous"—again, without any showing that their registration disrupted commerce.

The government's third interest—avoiding the appearance that it approves of the message of registered trademarks—was rejected in *Tam*, There, this Court squarely held that trademarks are private, not government, speech, *Tam*, 137 S. Ct. at 1760 (unanimous opinion), and noted that "[t]he PTO has made it clear that registration does not constitute approval of a mark." *Id.* at 1759 (unanimous opinion). As a result, "it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means." *Id.*

The government seeks to evade strict scrutiny by invoking inapposite doctrines governing at public universities, government subsidies, and commercial speech. Pet. Br. 19–23. But none of these doctrines is applicable here, where the government seeks to regulate private speech in the general marketplace of ideas because it deems it immoral.

First, the scandalous-marks prohibition is not associated with the running of a public university. The Court's rulings in the public university cases are "shaped by the educational context in which [they] arise[ ] ... : First Amendment rights ... must be analyzed in light of the special characteristics of the

school environment." *Christian Legal Soc'y Chapter of the Univ. of Cal. Hastings Coll. of the Law v. Martinez*, 561 U.S. 661, 685–86 (2010) (quoting *Widmar v. Vincent*, 454 U.S. 263, 267 n. 5 (1981) (internal quotation marks omitted)). Those characteristics are not present here, where the government seeks to regulate private speech irrespective of where it is expressed.

Second, as four Justices agreed in *Tam*, the government subsidy cases—including *Rust v. Sullivan*, 500 U.S. 173 (1991), *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540 (1983), and *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 570 U.S. 205 (2013)—are also inapposite.[3] "The federal registration of a trademark is nothing like the [subsidy] programs at issue in th[o]se cases." *Tam*, 137 S. Ct. at 1761 (plurality opinion). Likewise, *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009) and *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007), "occupy a special area of First Amendment case law, and they are far removed from the registration of trademarks." *Tam*, 137 S. Ct. at 1762 (plurality opinion).[4]

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[3] Section III-B of Justice Alito's decision, addressing the applicability of government subsidy cases to trademark registration, was not joined by Justice Kennedy on the ground that it was not necessary to resolve the issue before the Court. *See Tam*, 137 S. Ct. at 1765 (Kennedy, J., concurring in part).

[4] Section III-C of Justice Alito's opinion was joined by Chief Justice Roberts, and Justices Thomas and Breyer. Justice Kennedy's concurrence in part, which was joined by Justices Ginsburg, Sotomayor and Kagan, declined to address whether the trademark registration scheme is subject to lesser scrutiny, reasoning that the disparagement clause constituted viewpoint-discrimination and was therefore unconstitutional regardless of

Third, this is not a regulation of commercial speech, as the scandalous-marks provision regulates nothing commercial about the mark. *See Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980). It regulates trademarks on the basis of their perceived "immorality," wholly unrelated to any commercial regulatory interest. *See Tam*, 137 S. Ct. at 1763 (plurality opinion). The commercial speech doctrine's intermediate scrutiny is predicated on the government's regulation of commercial transactions. Laws that do not serve that interest are not properly subject to commercial speech analysis. Thus, a law that denied registration to "liberal" or "conservative" marks would not be subject to intermediate review, even though it, too, would regulate marks used to sell goods. Where the government's interest is not in regulating commerce, the commercial speech doctrine does not apply.

In any event, the scandalous-marks provision would fail even intermediate scrutiny, because it is not "narrowly drawn" to serve a "substantial interest." *Central Hudson*, 447 U.S. at 564–65. Justice Alito's plurality opinion in *Tam* explained that "the disparagement clause [could not] withstand even *Central Hudson* review" because the clause is "far too broad" and because "[if] affixing the commercial label permits the suppression of any speech that may lead to political or social 'volatility,' free speech would be endangered." *Tam*, 137 S. Ct at 1764–65 (plurality opinion).

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the level of scrutiny applied. *See Tam*, 137 S. Ct. at 1765–69 (Kennedy, J., concurring in part).

IV. THE SCANDALOUS-MARKS PROVISION IS UNCONSTITUTIONALLY VAGUE.

The scandalous-marks provision is also unconstitutionally vague. *See* Pet. App. 40a n.6, 41a. Where a law is both content-based and vague, it creates an "obvious chilling effect." *Reno*, 521 U.S. at 871–72. That is plainly the case here.

This Court has examined statutes that vest unbridled discretion to regulate speech under both the First Amendment and the Due Process Clause. "It is a basic principle of due process that an enactment is void for vagueness if its prohibitions are not clearly defined." *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972). The requirement of clarity is especially stringent when a law interferes with First Amendment rights. *See Keyishian v. Bd. of Regents*, 385 U.S. 589, 604 (1967). The Constitution requires the government to define restrictions on speech with clarity both to ensure procedural fairness and to avoid chilling speech.

Section 2(a) provides little practical guidance to the PTO as to the meaning of "scandalous," or "immoral," leading to a long line of arbitrary and contradictory decisions. The TMEP states that in evaluating whether a mark is scandalous, trademark examiners should consider the potential offensiveness of a mark to a "substantial composite of the general public." TMEP § 1203.01. But the manual offers no further guidance as to how to identify such a "substantial composite," much less how to discern what that "composite" thinks is scandalous or offensive. It effectively requires the examiner to guess at an entirely hypothetical audience's reaction to a particular mark. The

legislative history of the Lanham Act provides no further explanation. While it is sometimes the case that "[a] term that appears vague on its face may derive much meaningful content from the purpose of the Act, its factual background, and the statutory context," *Thomas v. Union Carbide Agric. Prods. Co.*, 473 U.S. 568, 593 (1985) (citation and quotation marks omitted), no such purpose, background, or context helps to clarify Section 2(a). *See* TMEP § 1203.1.

The lack of clear standards is exemplified by the PTO's long history of bizarre and contradictory enforcement of the scandalous-marks provision: The very same terms have been granted registration in one case and denied in another, with no seeming continuity of logic. For example:

- The PTO rejected FUCT for use on clothing,[5] but registered "FAUQ Yeah!" for leisure wear associated with a bakery.[6]
- The PTO rejected "Hot Shitz" for use on food seasonings, [7] but registered "DEMSHITZ" for a water sports website and blog.[8]

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[5] U.S. Trademark Application Serial No. 74368986 (originally filed Mar. 18, 1993).

[6] Registration No. 5282969.

[7] U.S. Trademark Application Serial No. 88101544 (Filed Aug. 31, 2018). Consideration of this application has been suspended pending the outcome of this case.

[8] Registration No. 4129054.

- The PTO rejected "The Complete A**hole's Guide To . . ." as a trademark for a series of books providing information relating to advice, counseling, self-help, and humor,[9] but registered "Managing Your Inner A**hole," for books on the development of emotional intelligence.[10]
- The PTO rejected "Wanker" for use on clothing,[11] but registered it for use on beer.[12]
- The PTO rejected "Titmouse" for use on computer cursor control devices,[13] but registered "TitmouseInc." for animation production services.[14]
- The PTO rejected "Pussy Power" as a mark for entertainment services,[15] but accepted "PussyPowerRevolution" for

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[9] U.S. Trademark Application Serial No. 76,351,811 (filed Dec. 21, 2001).

[10] U.S. Trademark Application Serial No. 85,711,056 (filed Aug. 23, 2012) (not registered on other grounds).

[11] U.S. Trademark Application Serial No. 78,610,369 (filed Apr. 16, 2005).

[12] Registration No. 2,036,108.

[13] U.S. Trademark Application Serial No. 78,954,967 (filed Aug. 18, 2006).

[14] Registration No. 4,624,689.

[15] U.S. Trademark Application Serial No. 77,387,209 (filed Feb. 2, 2008).

use on clothing.[16]

In light of this decisional patchwork, no trademark applicant can ever be on notice as to what words or ideas will trigger PTO rejection. The PTO's sole limiting principle in applying Section 2(a) requires an examining attorney who believes a pending trademark is scandalous or immoral to "consult with his or her supervisor" if she believes, "for whatever reason, that a mark may be considered to comprise such matter," in order to "ensure consistency in examination with respect to immoral or scandalous matter." TMEP § 1203.01. But as the examples above make clear, having two people speculate about hypothetical audiences' subjective reactions to ostensibly "immoral" speech does nothing to cure the fundamental problem that a vague standard presents. The only thing that is consistent about the PTO's application of the scandalous-marks clause is its inconsistency.

Furthermore, the PTO's perpetual ability to revisit the offensiveness of existing trademarks and revoke them at any time magnifies the problems of insufficient notice and chilling effect. Applicants not only have to guess what the PTO may find scandalous or immoral today, but also what it may find objectionable years from now—long after substantial resources have been invested in establishing a recognizable mark. Those who wish to register a mark must therefore make their best guess about how to survive the timeless gauntlet of Section 2(a)'s moral judgment—by self-censoring.

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[16] Registration No. 4,507,246.

What may be deemed acceptable today may become scandalous tomorrow. For example, the word "occupy" had a strong sexual connotation in the 17th and 18th centuries, but it no longer carries that meaning.[17] In general, Americans seem to have grown more accepting of the use of profanity.[18] But terms commonly used to describe members of minority groups in the past are often deemed deeply offensive today. Therefore, in evaluating trademark applications against the scandalous-marks provision, the PTO is forced to measure the anticipated reaction of a substantial portion of the general public on an issue that is shifting over time.

Accordingly, Section 2(a) is impermissibly vague and grants government power to regulate without sufficient guidance, resulting in inconsistent and unconstitutional administrative action.

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[17] Merriam-Webster Dictionary, *occupy*, https://www.merriam-webster.com/dictionary/occupy (last visited Mar. 19, 2019).

[18] See Jean M. Twenge, Hannah VanLandingham, & W. Keith Campbell, *The Seven Words You Can Never Say on Television: Increases in the Use of Swear Words in American Books, 1950–2008*, SAGE Open (2017), https://journals.sagepub.com/doi/pdf/10.1177/2158244017723689.

V. INVALIDATING THE SCANDALOUS-MARKS PROVISION WOULD BRING TRADEMARK LAW IN LINE WITH COPYRIGHT AND PATENT LAW, WHERE VIEWPOINT-BASED "MORALITY" JUDGMENTS PLAY NO ROLE.

Declaring the scandalous-marks provision unconstitutional requires no extension of existing jurisprudence in light of this Court's decisions in *Tam* and *Cohen*. The government should not be in the business of regulating private speech based on assessments about whether it will be deemed "offensive" or "immoral," but should leave those judgments to the marketplace. Such a holding will bring trademark law into line with two other areas of intellectual property regulation—copyright and patent law—both of which secure intellectual property rights without authorizing government officials to make *ad hoc* and inevitably speculative judgments about the moral acceptability of private speaker's viewpoints.

As copyright law demonstrates, offensive ideas promulgated by private individuals are not incompatible with a sound regime for regulating intellectual property. To the contrary, other intellectual property regimes rightly refuse to draw viewpoint- or content-based distinctions about morality. "Congress has enacted two statutory copyright restrictions that were arguably content based, but afterwards repealed them." *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 855 n.4 (5th Cir. 1979); *see also, e.g., Ex parte Murphy*, 200 U.S.P.Q. (BNA) 801, 802–03 (1977) (reversing the morality-based rejection of a patent for

a slot machine). "The gravity and immensity of the problems, theological, philosophical, economic and scientific, that would confront a court" asked to determine whether a given expression is morally worthy of copyright protection would be "staggering to contemplate." *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973). In requiring government officers to make necessarily subjective judgments about the moral acceptability of private viewpoints, Section 2(a)'s regulation of trademarks is a clear outlier. *See Mitchell Bros.*, 604 F.2d at 855 n.4; *Belcher*, 486 F.2d at 1088.

While many copyrighted works are undoubtedly offensive to some subset of society, the government wisely leaves such judgments to the marketplace of ideas. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (Holmes, J.) (declining to become the "final judges of the worth of" any particular expressions, instead entrusting that decision to the public marketplace). That is precisely what the First Amendment demands here as well.

CONCLUSION

For the reasons stated above, this Court should hold that the portion of Section 2(a) barring the registration of "immoral ... or scandalous" trademarks is unconstitutional.

Respectfully Submitted,

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